

REMARKS

This paper is being presented in response to the non-final official action dated May 10, 2006, wherein: (a) claims 1, 3, and 9 were pending; (b) claims 1 and 9 were rejected under 35 USC § 102(b) as being anticipated by Meguro et al. U.S. Patent No. 6,538,847 ("Meguro"); and, (c) claim 3 was rejected under 35 USC § 103(a) as being obvious over Meguro in view of Nepela U.S. Patent No. 6,330,131 ("Nepela"). Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

This paper is timely filed as it is accompanied by a petition under 37 CFR § 1.136(a) for an extension of time to file in the first month, and payment of the required extension fee.

I. The 35 USC § 102(b) Rejection Is Traversed

Claims 1 and 9 were rejected under 35 USC § 102(b) as being anticipated by Meguro. See pp. 2-3 of the action. Reconsideration is requested.

A. Proper Basis for a § 102(b) Rejection

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Additionally, "[t]he identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

The disclosure of a genus in the prior art is not necessarily a disclosure of every species that is a member of the disclosed genus. *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006). A prior art reference must describe a claimed range with *sufficient specificity* to anticipate the claim limitation. See *id.* at 999-1000; MPEP § 2131.03(II). Disclosed ranges that are considerably different from or that only slightly overlap a claimed range do not describe the claimed range with sufficient specificity. See *Atofina*, 441 F.3d at 999-1000 (reversing findings of anticipation on the basis that (1) a disclosure of 100 to 500 °C was considerably different from a claimed range of 330 to 450 °C, (2) a disclosure of 150 to 350 °C only slightly overlapped a claimed range of 330 to 450 °C, and (3) a disclosure of a concentration ratio of 0.001 to 1.0 % only slightly overlapped a claimed range of 0.1 to 5.0 %); accord *Ex parte Donohoe*, 2006 WL 2361355, Slip Op. at 9 (B.P.A.I. 2006) (Appeal No. 2005-2239) (reversing a finding of anticipation on the basis that a disclosed argon flow rate of "between about 100 to 200 sccm" did not describe a claimed flow rate of "up to about 100 sccm" with sufficient specificity).

B. The § 102(b) Rejection Is Traversed

The action asserts that the following passage in Meguro amounts to a disclosure of the recited range of 10 Å to 30 Å in claim 1:

After subjected to the FEAB machining process, a protective film (not shown) of diamond-like carbon (DLC), etc. is formed over the entire medium-facing surface in a thickness of several nanometers to protect the tip portion from moisture and corrosive gases.

Meguro, col. 9, lines 24-28. See pp. 2-3 of the action. The action relies solely on a dictionary definition of “several” as meaning “an indefinite number more than two and fewer than many.” See p.4 of the action.

Even assuming that the proffered dictionary definition of “several” is controlling regarding the interpretation attributed to Meguro by a skilled artisan, Meguro still fails to described the recited range of 10 Å to 30 Å with sufficient specificity to anticipate claim 1. Two possible interpretations of Meguro’s disclosure using the action’s definition include “more than 20 Å and less than many Å” and “at least 30 Å and less than many Å.” Given the open-ended nature of the upper bound of such disclosures (i.e., “many Å”), their breadth is so large compared to the claimed span of only 20 Å (i.e., 10 Å to 30 Å) that they are considerably different from the range recited in claim 1. Further, under either interpretation, Meguro’s disclosure only slightly overlaps/touches the range of claim 1. Accordingly, Meguro fails to describe the range of claim 1 with sufficient specificity and the anticipation rejection should be withdrawn. See *Atofina*, 441 F.3d at 999-1000; *Donohoe*, Slip Op. at 9.

C. The Official Action Has Not Considered the Appropriate Extrinsic Evidence in Interpreting the Disclosure of Meguro

When the applicant traverses a rejection, the official action should answer the substance of the applicant’s argument. See MPEP § 707.07(f). The applicant has submitted legal authority for the consideration of extrinsic evidence and extrinsic evidence itself relevant to the meaning of “several nanometers” as used in Meguro. See Sections II.A and II.B of the applicant’s “Amendment C.” The official action presents none of (1) contrary legal authority suggesting the inapplicability of non-dictionary extrinsic evidence, (2) contrary extrinsic evidence suggesting an alternate interpretation of “several nanometers” as used in Meguro, or (3) any argument as to why a general purpose dictionary providing only a vague definition of “several” is more pertinent than multiple references in the relevant art providing numeric dimensions for protective layers. Accordingly, the applicant submits that the *minimum* reasonable interpretation of “several nanometers” in view of the most relevant extrinsic evidence is 50 Å. See Section II.D of the applicant’s “Amendment C.”

Thus, the rejection of claim 1 as anticipated by Meguro is traversed for this additional, independent reason.

II. The 35 USC § 103(a) Rejection Is Traversed

Claim 3 was rejected under 35 USC § 103(a) as being obvious over Meguro in view of Nepal. See p. 3 of the action. As discussed above, Meguro fails discloses a protective film having a thickness of 10 Å to 30 Å formed on the surface of a magnetoresistive head portion facing a recording medium. Because Nepal does not remedy the deficiency of Meguro, their proposed combination fails to disclose all recited features of any of claims 1, 3, and 9. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the foregoing, reconsideration and withdrawal of the rejections and allowance of all pending claims 1, 3, and 9 are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

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